



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,577	05/21/2001	William R. Hartigan	11031.00	7975

33486 7590 09/09/2005

HEIMBECHER & ASSOCIATES, LLC.  
390 UNION BLVD  
SUITE 650  
LAKEWOOD, CO 80228-6512

EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/862,577	<b>Applicant(s)</b> HARTIGAN, WILLIAM R.	
	<b>Examiner</b> Vanel Frenel	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the application filed 05/21/01. Claims 1-10 are pending.

### ***Claim Objections***

2. Claims 5 and 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In this case, claims 5 and 10 are directed to a "computer readable- medium", but are dependent on claims directed to a computer-implemented method. It is unclear how a computer readable-medium constitutes a further limitation of a method. Computer instructions on a medium does not actively perform method steps.

### ***Claim Rejections - 35 USC §101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

4. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-10 recite a computer-implemented method for providing insurance information across a network preamble but not include "a computer readable- medium" or "a computer system" perform the recited steps in the body of claims.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, claims 1-10 recite a computer-implemented method for providing insurance information across a network preamble but not include “a computer readable- medium” or “a computer system” perform the recited steps in the body of claims.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In this present case, the claimed invention produces in the event that the user is a holder, permitting the holder to view insurance information for the insured corresponding to the holder's access code and password (i.e., repeatable) used in displaying an exception report to the holder, the exception report indicating which of the insured's insurance information violated the set of requirements (i.e., useful, and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-10 are deemed to be directed to non-statutory subject matter. In order for a claim to be statutory, the claimed invention must produce a useful, concrete, and tangible result and having “a computer system” or “a computer-medium” tied with the body of the claim in performing the recited steps.

As such, claims 1-10 do not recite any application or use of the technological arts, and thus equally rejected under 35 U.S.C 101.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quido et al (2003/0093302) in view of Lerner et al (2002/0087364).

(A) As per claim 1, Quido discloses a computer-implemented method for providing insurance information across a network, comprising:

receiving an access code from a user (See Quido, Page 2, Paragraphs 0022-0023);

receiving a password from a user (See Quido, Page 4, Paragraph 0041);

determining the user class of the user from the access code and password (See Quido, Page 4, Paragraphs 0044-0046);

in the event that the user is an agent, permitting the agent to enter insurance information for an insured (See Quido, Page 2, Paragraph 0022);

storing the insurance information along with the date and time of entry as a record (See Quido, Page 5, Paragraphs 0057-0058);

generating an access code and password corresponding to the insured (See Quido, Page 4, Paragraphs 0044-0046);

in the event that the user is a holder, permitting the holder to view insurance information for the insured corresponding to the holder's access code and password (See Quido, Page 4, Paragraphs 0044-0046).

Quido does not explicitly disclose that the method having receiving a set of requirements from the holder; and displaying an exception report to the holder, the exception report indicating which of the insured's insurance information violated the set of requirements.

However, these features are known in the art, as evidenced by Lerner. In particular, Lerner suggests that the method having receiving a set of requirements from the holder; and displaying an exception report to the holder, the exception report indicating which of the insured's insurance information violated the set of requirements (See Lerner, Page 5, Paragraph 0041).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lerner within the system of Quido with the motivation of providing quantitatively assess individual insurability risk factors and offer a binding life insurance to a potential customer via an automated tool. (See Lerner, Page 1, Paragraph 0008).

(B) As per claim 2, Lerner discloses the method wherein a holder may enter a plurality of access codes and passwords, each of the plurality of access codes and

passwords corresponding to a single insured of a plurality of insureds (See Lerner, Page 2, Paragraphs 0020-0022).

The motivation for combining the teachings of Quido and Lerner is as given above in the rejection of claim 1 above, and incorporated herein.

(C) As per claim 3., Lerner discloses the method further comprising:

permitting the holder to view insurance information for each of the plurality of insureds simultaneously, and displaying a compliance report to the holder, the compliance report indicating which of each of the plurality of insureds' insurance information violates the set of requirements (See Lerner, Page 3, Paragraphs 0027-0030; Page 4, Paragraphs 0032-0033).

The motivation for combining the teachings of Quido and Lerner is as given above in the rejection of claim 1 above, and incorporated herein.

(D) As per claim 4, Lerner discloses the method wherein the compliance report is presented as a table, the table having one row corresponding to each of the plurality of insureds and one column corresponding to each requirement of the set of requirements (See Lerner, Page 0035-0036).

The motivation for combining the teachings of Quido and Lerner is as given above in the rejection of claim 1 above, and incorporated herein.



Art Unit: 3626

(E) As per claim 5, Lerner discloses a computer-readable medium containing computer-implemented instructions which when executed, perform the method of claim 4 (See Lerner, Page 4, Paragraphs 0030- 0031).

The motivation for combining the teachings of Quido and Lerner is as given above in the rejection of claim 1 above, and incorporated herein.

(F) As per claim 6 Lerner discloses a computer-implemented method for retrieving and evaluating insurance information across a network, comprising:

inputting an access code and password for at least one insured (See Lerner, Page 2, Paragraph 0023);

receiving at least one insurance record comprised of at least one category of insurance coverage for the at least one insured (See Lerner, Page 3, Paragraph 0024) ;

inputting at least one user-specified insurance requirement (See Lerner, Paragraph 0024);

comparing the insurance record to the user-specified insurance requirement (See Lerner, Page 3, Paragraph 0027);

and

displaying the results of the comparison (See Lerner, Page 5, Paragraphs 0039-0041).

The motivation for combining the teachings of Quido and Lerner is as given above in the rejection of claim 1 above, and incorporated herein.

(G) As per claim 7, Lerner discloses the method wherein the step of comparing the insurance record to the user-specified insurance requirement comprises:

determining whether the user has specified a coverage minimum for at least on: insurance category (See Lerner, Page 1, Paragraph 0012);

determining from the at least one category of insurance coverage comprising the at least one insurance record whether the at least one insured's coverage meets or exceeds the coverage minimum (See Lerner, Page 3; Paragraphs 0024-0025);

creating a table, the table comprised of at least one row corresponding to each of the at least one insured and at least one column corresponding to each of the at least one categories of insurance coverage, the intersection of the at least one row and at least one column forming at least one cell (See Lerner, Page 4, Paragraphs 0035-0036); and

placing in the at least one cell an indicator corresponding to the results of determining whether the at least one insured's coverage meets or exceeds the coverage minimum (See Lerner, Page 3, Paragraphs 0024-0025).

The motivation for combining the teachings of Quido and Lerner is as given above in the rejection of claim 1 above, and incorporated herein.

(H) As per claim 8, Quido discloses the method wherein the indicator further indicates whether the at least one insured's coverage is cancelled or expired (See Quido, Page 3, Paragraph 0025).

(I) As per claim 9, Quido discloses the method wherein the indicator indicating that the at least one insured's coverage is expired is the date of expiration (See Quido, Page 3, Paragraph 0025).

(J) As per claim 10, Lerner discloses a computer-readable medium containing computer-implemented instructions which, when executed, perform the method of claim 9 (See Lerner, Page 4, Paragraphs 0030- 0031).

The motivation for combining the teachings of Quido and Lerner is as given above in the rejection of claim 1 above, and incorporated herein.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches method for accessing and evaluating information for processing an application for insurance (5,809,478) and Driversshield.com signs Nationwide Agreement for Its Web-Based Collision Repair Program; PR Newswire; New York; Jun 19, 2000; pg 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday- Thursday from 6:30am-5:00pm.

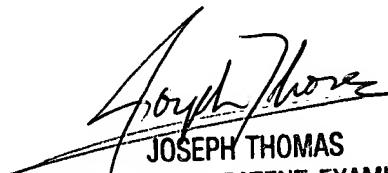
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F  
V.F

September 02, 2005

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600